



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,425	04/25/2001	Jonathan S. Stinson	23,369-129	1963

23452 7590 08/27/2003

PATENT DEPARTMENT  
LARKIN, HOFFMAN, DALY & LINDGREN, LTD.  
1500 WELLS FARGO PLAZA  
7900 XERXES AVENUE SOUTH  
BLOOMINGTON, MN 55431

EXAMINER

TENTONI, LEO B

ART UNIT	PAPER NUMBER
----------	--------------

1732

DATE MAILED: 08/27/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/843,425

Applicant(s)

STINSON, JONATHAN S.

Examiner

Leo B. Tentoni

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-32, 34-48 and 50-62 is/are pending in the application.
- 4a) Of the above claim(s) 59-62 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-32, 34-44 and 50-58 is/are allowed.
- 6) ☒ Claim(s) 45-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The objection to the disclosure and the rejection of claims 30-32, 34 and 36-38 under 35 U.S.C. § 102(e) set forth in the previous Office Action (Paper No. 5, mailed 10 April 2003) are withdrawn.

***Election/Restrictions***

2. Newly submitted claims 59-62 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The product as claimed (as set forth in claims 59-62) can be made by another and materially different process such as a process including the step of braiding the filaments at a braid angle of from about 120 degrees to about 150 degrees. The product as claimed can also be made by another and materially different process such as a process including the steps of braiding filaments on a first mandrel having a first diameter, disposing the formed structure on a second mandrel having a second diameter less than the first diameter, selecting an annealed diameter D and annealing the formed structure at a temperature between a glass transition temperature of a bioabsorbable material and a melting temperature of a bioabsorbable material to form an annealed prosthesis structure having an annealed diameter D when in a free state, less than the initial diameter of the prosthesis structure before annealing, the annealed prosthesis structure further being radially compressible to reduced diameters less than the annealed

Art Unit: 1732

diameter D and radially self-expandable from the reduced diameters. This new invention also has a classification (623/1.22) which is different from the classification (264/103) of the original claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 59-62 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 45-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmitt et al (U.S. Patent 5,697,969).

Schmitt et al (see the entire document, in particular, Examples 4 and 6) teach a process of making a prosthesis as set

Art Unit: 1732

forth in the instant claims, including the use of two mandrels of differing diameter.

***Allowable Subject Matter***

5. Claims 30-32, 34-44 and 50-58 are allowable over the prior art references presently of record.

***Response to Arguments***

6. Applicant's arguments filed on 15 July 2003 have been fully considered but they are not persuasive. Applicant argues (page 12) that claims 45-48 are allowable because claim 45 includes the limitation of (now cancelled) claim 49. Examiner responds that claims 45-49 were rejected under 35 U.S.C. § 102(e) over Schmitt et al, and it is not clear how incorporating the subject matter of claim 49 into claim 45 renders claims 45-48 allowable.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

Art Unit: 1732

statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo B. Tentoni whose telephone number is (703) 308-3834. The examiner can normally be reached on Monday - Friday (6:30 A.M. - 3:00 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni can be reached on (703) 305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*Leo B. Tentoni*

Leo B. Tentoni  
Primary Examiner  
Art Unit 1732

lbt